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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/037, 460 03/10/98 HASTINGS G 325800-626 (P)

HM12/0124

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EXAMINER

SADUD, C

ART UNIT

PAPER NUMBER

1646 *16*

**DATE MAILED:**

01/24/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Advisory Action</b>	Application No. <b>09/037,460</b>	Applicant(s) <b>HASTINGS et al.</b>
	Examiner <b>Christine Saoud</b>	Group Art Unit <b>1646</b>

THE PERIOD FOR RESPONSE: [check only a) or b)]

- a)  expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b)  expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

Appellant's Brief is due two months from the date of the Notice of Appeal filed on \_\_\_\_\_ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on Dec 22, 1999 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

The proposed amendment(s):

- will be entered upon filing of a Notice of Appeal and an Appeal Brief.
- will not be entered because:
  - they raise new issues that would require further consideration and/or search. (See note below).
  - they raise the issue of new matter. (See note below).
  - they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
  - they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

\_\_\_\_\_

\_\_\_\_\_

Applicant's response has overcome the following rejection(s):

\_\_\_\_\_

\_\_\_\_\_

Newly proposed or amended claims \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.

The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:

The issue of contiguous nucleotides has not been addressed or resolved by the amendments, therefore, the double patenting rejection and 102(e) rejections are being maintained for the reasons of record.

The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: 54-67, 75-92, 102-107, 109, 110, 113, and 114

Claims objected to: \_\_\_\_\_

Claims rejected: 108, 111, and 112

The proposed drawing correction filed on \_\_\_\_\_  has  has not been approved by the Examiner.

Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). 14.

Other

Art Unit: 1646

***Attachment to Advisory Action***

Applicant's After Final Amendment has been received and entered. However, it does not place the application in condition for allowance. The outstanding issues are repeated below.

1. Claims 108 and 111-112 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 08/196,362 (SEQ ID NO:7788 and 7775), 08/346,731 (SEQ ID NO:552), 08/420,856 (SEQ ID NO:552), 08/221,623 (SEQ ID NO:114), and 08/276,163 (SEQ ID NO:15161). Although the conflicting claims are not identical, they are not patentably distinct from each other because they encompass common subject matter of contiguous nucleotides of SEQ ID NO:1 of the instant application. Therefore, the instant claims directed to nucleic acids comprising 30 or 50 contiguous nucleotides would be encompassed by the nucleic acids of the above mentioned applications.
  
2. Claims 108 and 111-112 are provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending Application No. 08/196,362 (SEQ ID NO:7788 and 7775), 08/346,731 (SEQ ID NO:552), 08/420,856 (SEQ ID NO:552), 08/221,623 (SEQ ID NO:114), and 08/276,163 (SEQ ID NO:15161) which have a common assignee with the instant application.

Art Unit: 1646

Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future patenting of the copending application.

This provisional rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine Saoud, Ph.D., whose telephone number is (703) 305-7519. The examiner can normally be reached on Monday to Friday from 8AM to 3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623. The fax phone number for this Group is (703) 308-0294.

Official papers filed by fax should be directed to (703) 308-4227. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Christine Saoud, Ph.D.  
January 20, 2000

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*Gary L. Kunz*  
GARY L. KUNZ  
PRIMARY EXAMINER  
GROUP 1200